

### **REMARKS**

This amendment is responsive to the Office Action dated March 9, 2004. Applicant has amended claims 1-7, cancelled claims 8-10 and added new claims 11-13. Claims 1-7 and 11-13 are pending.

#### **Claim Rejection Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 1-7, under 35 U.S.C. 103(a) as being unpatentable over Dworkin (US 4,992,940) in view of Sales Force Automation Article (hereafter “SFA”), Joseph (US 5,878,401), and Bennett et al. (US 4,591,983). Applicant respectfully traverses the rejection to the extent such rejections may be considered applicable to the claims, as amended. The applied references fail to disclose or suggest the inventions defined by Applicant’s claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

In order to establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference or references when combined must teach or suggest each and every claim limitation. Second there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success.<sup>1</sup> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant’s disclosure. The reasoning set forth by the Examiner fails these well-established criteria. Accordingly, Applicant respectfully traverses the rejection under 35 U.S.C. 103(a) for the reasons set forth herein.

With reference to independent claim 1, for example, the applied references lack any teaching that would have suggested receiving a value input associated with each of the desired option selections and using the value input to determine a configured product containing some

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<sup>1</sup> See MPEP 706.02(j) quoting *In re Vaick*, 947 F2d 488, 20 USPQ2d 1438 (Fed Cir. 1991).

but not all desired option selections that most closely matches the configured product having the desired option selections of the customer.

In regard to claims 1-7, the Examiner indicates that one of ordinary skill in the art would have been motivated to modify the a product sales assistance system of Dworkin with the various teaching of SFA, Joseph, and Bennett et al. to address admitted deficiencies in all of the references. Specifically, the Examiner admits various deficiencies in each of the asserted references in the prior Office Action of July 1, 2003. These asserts are implicitly restated in the Office Action of March 2004 as the latest Office Action does not expressly recite a rejection, but rather asserts that Applicants arguments in response the the previously asserted rejection are non-persuasive. The Examiner recognizes that Dworkin fails to teach or suggest use of desired option selections for defining configured products. The Examiner also recognizes that Dworkin fails to teach or suggest identifying configured products in the inventory of the selling entity. The Examiner recognizes that Dworkin fails to teach or suggests the use of configuration rules to define configured products from available options, and subsequent use of value input associated with desired option selections are recited within the claims. Similarly, Examiner recognizes that SFA does not teach or suggest identifying configured products in the inventory of the selling entity.

The Examiner also recognizes that both SFA and Joseph fails to teach or suggest identifying configured products in the inventory of the selling entity, use of configuration rules to define configured products from available options, and use of value input associated with desired option selections are recited within the claim. The Examiner finally recognizes that none of the references teach or suggest use of value input associated with desired option selections are recited within the claims.

It is well established that the Examiner bears the burden of establishing a prima facie case of obviousness.<sup>2</sup> In doing so, the Examiner must determine whether the prior art provides a “teaching or suggestion to one of ordinary skill in the art to make the changes that would

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<sup>2</sup> *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

produce” the claimed invention.<sup>3</sup> A prima facie case of obviousness is established only when this burden is met.

The Court of Appeals for the Federal Circuit recently addressed the evidentiary standard required to uphold an obviousness rejection.<sup>4</sup> Specifically, the Federal Circuit stated: “[the] factual question of motivation is material to patentability, and (can) not be resolved on subjective belief and unknown authority.<sup>5</sup> This finding must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner.<sup>6</sup> Deficiencies in the evidentiary record cannot be cured by general conclusions such as “general knowledge” or “common sense.”<sup>7</sup> Accordingly, the Examiner cannot rely on unsupported, conclusory statements to close holes in the evidentiary record.<sup>8</sup> Unless the Examiner can establish an evidentiary record based on concrete prior art references that establish that it would have been obvious to a person with ordinary skill in the art to incorporate the features of Applicant’s dependent claims, the claims should be allowed.

The conclusion of obviousness advanced by the Examiner relies on a motivation plucked directly from Applicants’ own disclosure, rather than the prior art. Indeed, the Examiner cited no prior art teaching as the source for the motivation. Moreover, the Examiner failed to explain why one of ordinary skill in the art would have considered it desirable “identifying one or more products using the value input associated with the desired option selections to determine one or more configured products found in the inventory of the selling entity that most closely matches the configured product having the desired option selections of the customer” in the Dworkin-SFA-Joseph-Bennett system.

For example, claim 1 recites identifying one or more products using the value input associated with the desired option selections to determine one or more configured products found in the inventory of the selling entity that most closely matches the configured product having the

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<sup>3</sup> *In re Chu*, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

<sup>4</sup> *In re Lee*, 61 USPQ2d 1430, (CAFC 2002).

<sup>5</sup> *Id.* at 1434.

<sup>6</sup> *Id.*

<sup>7</sup> *Id.*

<sup>8</sup> *Id.*

desired option selections of the customer. The Examiner has not even provided a reference that substantiates the existence of such a feature in other systems at the time of Applicant's filing, much less evidentiary support of motivation to combine this feature into the systems of the applied references. At a bare minimum, Applicant must be afforded an opportunity to rebut any evidence of use of a value input associated with the desired option selections, if such evidence exists. The current evidentiary record, however, does not even provide Applicant with that opportunity.

Furthermore, the Examiner has also identified no teaching in the prior art of a motivation to combine the teaching of the applied references to arrive at a sales assist system as claimed. Specifically, the Examiner has identified no motivation that would have led a person of ordinary skill on the art to modify the selection of configurable products from inventory of a seller of Dworkin using the configuration of products of SFA and the untaught use of a value input associated with the desired option selections.

The Court of Appeals for the Federal Circuit has made clear that motivation to combine references must be found in the prior art, and that it is impermissible hindsight for the Examiner to use the motivation stated in Applicant's own disclosure as a blueprint to reconstruct the claimed invention from the prior art.<sup>9</sup>

It is improper to point to teachings of motivation contained within Applicants' own disclosure.<sup>10</sup> Moreover, it is insufficient to merely pull such motivation out of thin air. Rather, the Examiner's rejection must be based on substantial evidence in the record demonstrated that the motivation for making the claimed invention resides in the prior art.<sup>11</sup> In this case, the Examiner has not only failed to identify a prior art reference that teaches a sales assist system that identifies one or more products using the value input associated with the desired option selections to determine one or more configured products found in the inventory of the selling

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<sup>9</sup> See *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (CAFC 1985); see also *In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988); see also *In re Gorman*, 18 USPQ 2d 1885, 1888 (CAFC 1991); see also *Al-Site Corp. v. VSI International, Inc.*, 50 USPQ2d 1161, 1171 (CAFC 1999).

<sup>10</sup> *In re Oetiker*, 24 USPQ2d at 1445.

<sup>11</sup> *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002); *In re Chu*, 36 USPQ2d at 1094.

entity that most closely matches the configured product having the desired option selections of the customer, but has also failed to identify anything that would have led a person of ordinary skill in the art to modify Dworkin to provide a sales assist system as claimed.

In summary, the Examiner's conclusion of obviousness, and particularly the cited motivation to modify Dworkin in view of SFA, Joseph and Bennett et al., is unsupported by any substantial evidence in the record.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 1-7 under 35 U.S.C. 103(a). Withdrawal of this rejection is requested.

**New Claims:**

Applicant has added claims 11-13 to the pending application. The applied references fail to disclose or suggest the inventions defined by Applicant's new claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed inventions. As one example, the references fail to disclose or suggest identifying one or more products using the value input associated with the desired option selections to determine one or more configured products found in the inventory of the selling entity that most closely matches the configured product having the desired option selections of the customer as discussed above, as recited by claim 11. No new matter has been added by the new claims.

### CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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